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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,203	12/03/2003	Nancy L. Klodt	P06446US00	5137
22885 7590 02/22/2007 MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			EXAMINER SUHOL, DMITRY	
			ART UNIT	PAPER NUMBER
			3725	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/22/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/727,203

Applicant(s)

KLODT, NANCY L.

Examiner

Dmitry Suhol

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-10 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1, 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Longo et al '449. Longo discloses a device which teaches most of the claim elements including a body (10) having a top surface (22) and a bottom surface (back of surface 22 including member 20) including magnetic material (20), the body defining a frame around an aperture (figures 1 and 2, 14a), educational information (read onto writing 17), a replaceable name tag (read onto picture 16 as it identifies an individual). Educational information of a name tag being presented on a second surface as required by claims 1 and 5-6 is read onto the picture on member 16 (as shown in figures 1 and 2) since it educates about the owner/user of the device. A sleeve having an opening as required by claim 1, is read onto member 21 with the opening being encompassed by the fact that the member 21 does not fully surround the edges of block 18 (see col. 1, lines 60+, where it is considered that the "opening allows for block 18 to be removed from the body 10 and thus allowing member 16 to be removed and replaced as desired. Limitations of claim 3 are shown as reading material 17 in figures 1 and 2. Limitations of

claim 7 are shown in figures 1 and 2 as writing 17 is disposed in the upper and lower regions of surface 22.

Longo fails to explicitly teach that his member 16 is comprised of a paper medium, however it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to have provided member 16 comprised of a paper medium since pictures are notoriously well known to be placed on a paper substrate for processing and cost reasons.

Regarding limitations of claims 4, it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to include matching decorative designs on member 16 and surface 22 since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983) and *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of matching decorative design does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter decorative designs and the substrate name tag and body which is required for patentability. It should be further noted that the decorative designs are

considered a design choice in that there is no criticality or advantage to having them disclosed by the applicants.

Claims 8-10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haupt '620 in view of McAllister '153, Greenberg '325 and Miller '902. Haupt discloses an educational device containing most of the claimed elements including, with respect to claim 8, a body (1) having a top surface and opposite bottom surface (figure 2), a replaceable name tag (3) having a first surface and a second surface where the second surface presents educational information (word pig). A replaceable name tag region is read onto the lower half region of member 1.

Haupt lacks the teaching of a bottom surface comprising a magnetic material as required by claim 8 the name tag comprising a paper medium as required by claim 8. However, McAllister discloses an educational device, like that of Haupt, which teaches that it is known to provide such devices with a magnetic bottom surface for the purpose of attaching such a device to a metallic article (col. 1, lines 58-67), while Greenberg discloses an educational device which uses a body with an aperture (32) that receives various cards which teaches that it is known to manufacture such devices from a paper medium (col. 3, lines 15). Therefore it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to having manufacture the bottom surface of Haupt from a magnetic material for the purpose of attaching the device to a metallic surface. It would have been further obvious to manufacture element (3) of Haupt comprising a paper medium for the purpose of cost of manufacture and since

Haupt clearly states that any materials of construction may be used in the manufacture of his device (page 1, lines 19-20).

Miller is relied upon to teach that teaching aids like that of Haupt and McAllister are known to be provided with one or more sleeves in replaceable tag regions for holding tags (32) which match educational material and decorative designs on the body of the aid (figures 1, 4 and 6). Therefore it would have been obvious to manufacture the device of Haupt with one or more replaceable name tag sleeves for the purpose providing a teaching aid with increasing complexity, especially since Haupt clearly states that multiple teaching topics are encompassed in his invention (lines 61-67). Furthermore it is the position of the examiner that the decorative design and placement of the educational material as claimed is purely a design choice in that applicants do not disclose any advantage or critical need for the decorative design or the placement of the educational material (see applicants specification page 4, lines 28-31).

It should be noted that regarding specific information carried by the body and the name tag, as required by claims 8-9, it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to provide the teaching aid with any of the claimed indicia since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of

Art Unit: 3725

display/educational information does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. educational and design indicia/information) and the substrate (e.g. name tag and device body) which is required for patentability.

Response to Arguments

Applicant's arguments filed 2/9/2007 have been fully considered but they are not persuasive. Applicants argue that member 15 is not a sleeve and does not contain an opening. In response the examiner points out that due to applicants amended language the sleeve is not read onto member 21 which clearly contains an opening (as stated above).

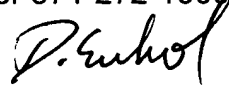
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3725

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Dmitry Suhol
Primary Examiner
Art Unit 3725

ds